

REMARKS

Reconsideration of the subject application is respectfully requested in light of the comments which follow. Claims 1-3, 5, 7-20 and 25-40 are pending.

Claim Objections

The Official Action indicated that Claim 1 was objected to as being indefinite because it is drawn to a single laminated floorboard but then recites a positive relation to a plurality of integral connectors and a second floorboard. Claim 1 is amended to more clearly show that the features of the claim are drawn only to a single floorboard. All references to the second floorboard are preceded by "adapted to" or similar language, to show a relationship the floorboard is intended to have with adjacent (second) floorboards.

The Official Action notes that the claim reads as though the connectors are separate for joining between two floorboards. Applicant respectfully traverses this objection. The preamble of the claim is drawn to "a rectangular laminated floorboard...comprising". The claim continues to recite that the floorboard comprises "integrated connectors at least along the opposing long edges of the floorboard". Thus, the claim provides that the integrated connectors are part of the floorboard, as the floorboard "comprises" this feature. Additionally, the connectors as claimed are "integrated" with the floorboard, and not separate as the Official Action suggests. Applicant respectfully submits that the amendments and remarks above clarify the subject matter of the claim so as to obviate the objection. Accordingly, the objection should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

Claims 1-3, 5, 7-20 and 25-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Martensson (U.S. Patent No. 6,763,643) in view of Nelson (U.S. Patent No. 2,497,837) for the reasons cited on pages 3-6 of the most recent Official Action. This rejection is respectfully traversed.

Claim 1 recites, *inter alia*, that the opposing long edges of the floorboard have a length not exceeding 80 cm, and the opposing short edges of the floorboard have a length not exceeding 10 cm. The Official Action correctly notes that Martensson does not disclose these features, and looks to the teachings of Nelson to cure Martensson's deficiencies. The Official Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Martensson as taught by Nelson, such that a Martensson's floorboard is made of Nelson's dimensions as a matter of design choice, in order to fit into particular areas where available space is an important consideration.

Nelson pertains to a floor embedded with working surfaces of wear-resistant and slip-preventing material disposed in a manner that material will always be under the foot of a person walking on the floor surface. The floor is comprised of individual floorboards. Nelson discusses using a floorboard having a width of 3 inches (7.62 cm) or more (Column 2, lines 8-9). However, contrary to the position set forth in the Official Action, Nelson does not disclose the length of the floorboard to be less than 80 cm. The Official Action relies on Nelson's disclosure in Column 1, lines 49-51, to meet this feature of Claim 1. This passage provides only that the a floorboard is of "considerable surface area" and has a "length greatly exceeding its width, which width usually does not exceed 12 inches". Importantly, the dimension not exceeding

12 inches is in the width direction, or the dimension of the short sides of the floorboard. This passage does not refer to the length of the board (length of the opposing long edges) other than noting the board has a length "greatly exceeding" its width. Thus, a floorboard of a greater length is suggested, and this disclosure actually teaches away from providing a floorboard having a shorter than standard length, as provided in Claim 1.

As noted above, the Official Action rationalizes combining the teachings of Nelson with Martensson, "in order to fit [the board] into particular areas where available space is an important consideration". To sustain a rejection on obviousness, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d, 1385 (2007). The reasoning provided in the Official Action does not meet this standard. In the industry, whole floorboards are typically cut down to size by the installer to fit in areas where the whole board would not fit, for example, near a wall surface. This is a result of the floor area not being of a dimension that is an exact multiple of the dimension of the floorboard. This conventional process is explained in U.S. Patent No. 6,863,768 to Haffner et al at Column 12, lines 58-64. Even if a floorboard is made of smaller dimensions, some degree of cutting will likely still be necessary to ensure a proper fit and complete coverage of floor area, unless the floor area is of certain dimensions that are exact multiples of the dimensions of the floorboards. Thus, in order to fit floorboards in areas where available space is a consideration, the floorboards are traditionally cut to size. Similarly, smaller floorboards would need the same treatment where they are not dimensioned to be exact multiples of the floor area.

Accordingly, one of ordinary skill in the art would not manufacture a new type of smaller floorboard, but rather cut existing standard floorboards to fit in an area where available space is a consideration.

Applicant also submits that the claimed dimensions of the floorboard offer an unexpected result that would not have been predictable to a person of ordinary skill in the art. Even if the Nelson patent taught the claimed dimensions, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. MPEP 2143.01, Part III.

As evidenced by declarations previously made of record in this application, the claimed floorboards provide numerous advantages that were neither expected nor predictable. The declaration by Mr. Gerhard Schultze confirms that floorboards of the claimed dimensions were not previously used in the industry because of the perception that they would lead to higher production costs and material waste. In addition, smaller floorboards were perceived to take more time to install. In the Mr. Svante Bernow's declaration it is demonstrated the claimed smaller floorboards can actually be installed in a shorter amount of time than the larger, standard size floorboards. As discussed in the instant specification beginning at line 21 of page 10, the smaller size lends to easier handling of the floorboards, reduced frictional surfaces along the sides of the joint portions, greater flexibility in the boards during installation which permits a lower force to be applied to snap-in the short sides of the boards. As supported by the above the declarations, these results were neither expected nor predicted, as the industry favored the larger floorboards.

Claims 15 and 26 recite features similar to those of Claim 1, including the dimensions of the floorboard. The arguments above regarding Claim 1 are incorporated by reference here, and apply to Claims 15 and 26 as well. Accordingly, withdrawal of the rejection of Claims 1, 15 and 26 is respectfully requested.

As an initial note, it is unclear if the rejections of Claims 25, 27 and 29 as set forth in the Official Action are made under 35 U.S.C. §103 or §102. While the claims are described as being rejected under §103, it appears an anticipatory approach has been taken, as there is no mention of obviousness in the rejection of these claims. Similarly, the rejection of Claim 32 is unclear, where an obviousness rejection is presented under §103, but the rejection is based on elements not recited in the claim. Applicant respectfully requests the Examiner to clarify the record.

Claim 25 pertains to method making a floor of mechanically locked rectangular laminated floorboards. The claim recites numerous method steps, including placing a second floorboard in a second row at an angle to a first floorboard in a first row with an upper joint edge of the second floorboard contacting with a joint edge of the first floorboard, locking a new floorboard in the second row to the short side of the second floorboard, and laterally displacing both the new and second floorboard parallel with respect to the long side of the first floorboard. The second floorboard and new floorboard are then angled down. A non-limiting example is illustrated in Figures 6a-6d and described beginning at line 8 of page 22 in the present application.

The Official Action takes the position that the floor of Martensson is "capable of" of being made by the claimed method. By asserting that the floor in Martensson need only be "capable of" of being made by the claimed method steps, the Official

Action appears to treat the method steps merely as functional limitations in an article claim. This approach is improper, as Claim 25 is a method claim. A claim is anticipated only if each and every elements as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Martensson only briefly mentions any steps to follow for making the floor, noting that the joining profile 10 has lips 4 that engage in grooves 11 of the floorboards (column 7, lines 13-15), and that some portions may be "snap joinable" (column 9, line 4). There is no discussion of the in Martensson of the method steps recited in Claim 25, specifically, the locking of the second floorboard and new floorboard together at a short side, laterally displacing both boards parallel with respect to a long side of a the first floorboard, and angling the second and new floorboards down after the lateral displacement, nor are these steps inherent in Martensson's disclosure.

Claim 27 pertains to a method of installing a flooring comprising first and second types of rectangular floorboards having integrated connectors. The first and second types of floorboards are mirror-inverted with regard to connectors. While the Official Action relies on Martensson in rejecting this claim, these features are not addressed.

Martensson discloses a floor made from a number of identical floorboards 1 (see Figure 6) that are joined by separate joining profiles 10. Each floorboard 1 has identical connecting elements, shown partly as a groove 4 along four sides of the bottom of a floorboard (Figure 1) and as separate joining profiles 10. Thus,

Martensson does not disclose a method of installing a floor using first and second types of floorboards.

Additionally, Martensson's floorboards are not mirror-inverted with regard to the connectors. As shown in Figures 1 and 6 of Martensson, the floorboards and connectors are identical. For the floor to be properly assembled, the joint profile 10 must be located on the same edge of all of the floorboards, when the joint profile is integrated with a single floorboard. This is further shown in Figures 6 and 8 where both long sides of each floorboard 1 has the same connector 4 and connection arrangement with joining profile 10. Similarly, each floorboard has identically arranged elements 21 and 22 along the edges of each respective floorboard. Nelson does not cure these deficiencies.

The Official Action makes reference to a "mirrored connector 10", however, it is not addressed how this equates to a first and second type of floorboards being mirror-inverted relative to each other with regard to the connector. This reference only addresses the connector itself, whereas the claim recites the first and second type of floorboards are mirror-inverted. Because neither Martensson nor Nelson disclose a method of installing a floor comprising first and second types of floorboards connectors arranged in a mirror-inverted manner relative to each other, withdrawal of this rejection is respectfully requested.

Further regarding Claim 27, the Official Action alleges that Martensson discloses the floorboards as being connected long side to short side, and short side to short side. The Official Action points to Figure 6 of Martensson and the "T shaped intersection of corners". Applicant respectfully disagrees with this interpretation.

Claim 27 recites that the first and second types of floorboards are joinable to each other "long side against short side". In Martensson, only a long side of one floorboard is "against" the long side of another floorboard. While the short side may be near a long side, it can not be reasonably interpreted as being "against" the long side. It is not seen how in an arrangement where two parallel long sides are in contact against each other, a perpendicularly arranged short side can also be arranged "against" the long side of the other board.

The Official Action indicates that Claim 29 is rejected for the same as reasons as presented in the rejection of Claim 1, and further notes that the floorboards of Martensson are capable of being joined in manner set forth in the claim. However, the Official Action does not address the feature of the claim that the floor includes first and second types of floorboards, and the first type is mirror-inverted relative to the second type with regard to the connectors. As noted above, Martensson discloses only a single type of floorboard to be used in the assembly of a floor and does not show the mirror-inverted configuration as claimed.

The rejection of Claim 32 as set forth in the Official Action is unclear. The rejection refers to Martensson as disclosing various elements of a floorboard, then relies on Nelson for a teaching of specific dimensions of the floorboard. However, Claim 32 does not recite specific dimensions of the floorboard.

Additionally, features recited in Claim 32 are not addressed in this rejection. Specifically, Claim 32 recites, *inter alia*, a flooring system comprising first, second, third, and fourth types of floorboards, where the long edges of the floor boards have a length that is an even multiple of the length of the short edges, a multiple of the first and second types of floorboards is smaller than a multiple of the third and fourth

types of floorboards, and the first and third types of floorboards, as compared with the second and fourth types of floorboards, respectively, are mirror-inverted with regard to the connectors. Claim 32 continues to recite that all of the first, second, third and fourth types of floorboards are joinable with each other long side against short side, short side against short side and long side against long side.

Martensson does not disclose any of the above features. As noted above, all of the floorboards in Martensson are identical, and of uniform length (Figure 6). Thus, only one type of floorboard is disclosed. The Official Action refers to the floorboards being capable of connecting in a horizontal and vertical direction with "mirror board edge image (fig 2c)". It is not clear if this sentence is intended to identify "mirror-inverted" relationship presented in the claim. As discussed above, the claimed mirror-inverted arrangement is not shown by Martensson either. Lastly, Martensson shows only long side against long side connections and short side against short side connections, but does not show, discuss, or even consider a short side against long side connection. Accordingly, withdrawal of this rejection is respectfully requested.

New Claims 39 and 40 are added for consideration. Support for these claims can be found in the drawings as originally filed, and in the specification beginning at line 11 of page 25. No new matter is added. These claims are introduced to more clearly recite the features of a mirror-inverted arrangement.

Claims 2, 3, 5, 7, 9-14, 16-19, 28, 30, 31, 33-40 ultimately depend from one of the independent Claims 1, 15, 25, 27, 29 or 32, which are allowable as discussed above. For at least this reason, these claims are also allowable.

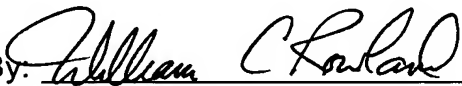
Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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